

REMARKS

Claims 1 through 8 are pending in this Application, of which claims 5 through 8 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Accordingly, claims 1 through 4 are active.

Claim 1 has been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, Figs. 1 and 10, and the related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1 and 2 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Shimizu et al.

In the statement of the rejection the Examiner referred to Fig. 19A of Shimizu et al., asserting the illustration of a semiconductor device corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There are significant differences between the claimed semiconductor device and the semiconductor device disclosed by Shimizu et al. that scotch the factual determination that Shimizu et al. disclose a semiconductor device identically corresponding to that claimed.

Specifically, the semiconductor device defined in independent claim 1 comprises, *inter alia*, an isolation insulator film 5a (Fig. 1) formed of two layers, a first oxide film 3 and an HDP-CVD oxide film 4. The second HDP-CVD oxide film 4 has an upper surface in contact with a portion of the floating electrode 7a, 7b, and the upper surface of the HDP-CVD oxide film 4 extends downwardly toward semiconductor substrate 1. Further, the portion of the floating gate 7a, 7b in contact with HDP-CVD oxide film 4 extends lower than the main surface of the semiconductor substrate. None of these features appear in the semiconductor device disclosed by Shimizu et al. Indeed, it is not apparent wherein Shimizu et al. disclose a semiconductor device wherein the isolation insulator film in the trench comprises two layers as in the claimed invention, much less a second HDP-CVD oxide film having an upper surface that is not only in contact with a portion of the floating electrode but also extends downwardly toward the semiconductor substrate, let alone wherein the portion of the floating gate in contact with the HDP-CVD oxide film extends below the main surface of the semiconductor substrate.

The above-argued structural differences between the claimed semiconductor device and the semiconductor device disclosed by Shimizu et al. undermine the factual determination that Shimizu et al. disclose a semiconductor device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 and 2 under 35 U.S.C. § 102 for lack of novelty as evidenced by Shimizu et al. is not factually viable and, hence, solicit withdrawal thereof.

Claim 3 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Shimizu et al. in view of Tseng.

Claim 4 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Shimizu et al. in view of Nishioka et al.

Each of the above rejections under 35 U.S.C. § 103 is traversed. Specifically, each of claims 3 and 4 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Shimizu et al. Neither of the secondary references to Tseng and Nishioka et al. cures the previously argued deficiencies of Shimizu et al. Moreover, there is no apparent factual basis upon which to predicate the conclusion that one having ordinary skill in the art would have been realistically motivated to dramatically restructure the semiconductor device disclosed by Shimizu et al. to arrive at the claimed invention absent improper reliance upon Applicants' disclosure. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

Applicants, therefore, submit that the imposed rejection of claim 3 under 35 U.S.C. § 103 for obviousness predicated upon Shimizu et al. in view of Tseng, and the imposed rejection of claim 4 under 35 U.S.C. § 103 for obviousness predicated upon Shimizu et al. in view of Nishioka et al., are not factually or legally viable and, hence, solicit withdrawal thereof.


Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

Application No.: 10/612,913

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Arthur J. Steiner

Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AJS:as:ntb
Facsimile: 202.756.8087
Date: December 30, 2004

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